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09/724,710	11/28/2000	John Thomas Amend	47692-00003USPT	7699

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EXAMINER

BASHORE, ALAIN L

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 04/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/724,710

Applicant(s)

AMEND ET AL.

Examiner

Alain L. Bashore

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M6

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-124 is/are pending in the application.
- 4a) Of the above claim(s) 24-124 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Group I, claims 1-23, in Paper No. 17 is acknowledged. The traversal is on the ground(s) that groups 1-3 are not independent and the entire requirement is factually unsupported. Also, all seventeen groups are classified within the same class/subclass.

This is not found persuasive because: each restricted group includes as the factual basis the preambles of the claims of the requirement. The preambles indicate separate inventions in the art. Regarding same classifications, there is currently no breakdown of subclasses along the subject matters recited that would allow for more precise classification.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 24-119 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected inventions, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 17.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 2-23 are rejected under 35 U.S.C. 101 as non-statutory because the method claims as presented do not claim a technological basis. Without a claimed basis, the claim may be interpreted in an alternative as involving no more than a manipulation of an abstract idea and therefore non-statutory under 35 U.S.C. 101. In contrast, a method claim that includes in the preamble and body of the claim structural / functional interrelationships that are solely by computer (and non-trivial) are considered to have a technological basis [See *Ex parte Bowman*, 61 USPQ2d 1669, 1671 (Bd. Pat. App. & Inter. 2001) – used only for content and reasoning since not precedential].

5. Claim 1 is rejected under 35 U.S.C. 101 because the claim as currently written encompass non-statutory subject matter.

A claim directed to or including within its scope a human being will not be considered to be patentable subject matter under 35 USC 101. The grant of a limited, but exclusive property right in a human being is prohibited by the constitution. Accordingly, a claim or part of a claim that may include a human being within its scope must include limitations to avoid even inferentially claiming a human being. The use of a negative limitation to define the metes and bounds of the claimed subject matter is permissible to obviate this rejection. See *In re Wakefield*, 422 F.2d 897, 164 USPQ (CCPA 1970).

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Specifically, the following recitations appear to claim a human being: “a real estate facilitator”. This recitation may be considered a real estate agent. The term “network” may be considered the human relationships that construct a “network”.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 1 and 2 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 1 and 2 recite “non-binding” and “without obligation”. These recitations are considered negative limitations, which do not have basis in the original disclosure and therefore are rejected under 35 U.S.C. 112, first paragraph as failing to comply with the written description requirement.

Any negative limitation or exclusionary proviso must have basis in the original disclosure. See MPEP § 2163 - § 2163.07(b) for a discussion of the written description requirement of 35 U.S.C. 112, first paragraph.

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8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting structure elements or essential structural cooperative relationships of elements. An apparatus claim must recite structural elements. The omission may also be considered a gap between necessary structural connections. See MPEP § 2172.01. While the system claim is now construed as an apparatus claim, it is unclear if any structure is recited. The terms "network", "facilitator", and "database" may all be software or method limitations per se. No structure appears to be positively recited.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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11. Claims 1-2, 13-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Good et al in view of Keithley et al in view of Walker et al ('878) in further view of Walker et al ('129).

Good et al discloses a network (12) and real estate facilitator (13) connected to the network. The real estate facilitator is capable of communicating with the at least one prospective tenant and a plurality of landlords (col 4, lines 21-26, 36-41). The prospective tenant submits information specifying desired real estate (col 5, lines 63-67; col 6, lines 1-26). The facilitator includes a real estate database (col 4, lines 27-30). The facilitator allows at least one prospective tenant to select a piece of real estate in which the collection is formed responsive to the at least one desired characteristic of real estate. Good et al discloses virtual reality tours (col 3, lines 20-24) and actual visits to sites (col 3, line 37). The system and method to Good et al is real estate acquisition (finding a rental property) and outfitting (providing analysis), and the phases disclosed include: a real estate phase and an analysis phase. Good discloses a prospective tenant: reviewing a list of real estate, selecting real estate that meets at least one preliminary criterion.

Good et al does not disclose:

a real estate demand database;

a building database;

a real estate supply database.

Keithley et al discloses a real estate demand database (col 6, lines 43-49), a building database (col 6, lines 30-40).

It would have been obvious to one with ordinary skill in the art to include a building database and demand database to Good et al because Keithley et al teaches rental property information demand (col 1, lines 49-51) and Good et al teaches that landlords must find new ways to attract renters (col 2, lines 35-39).

Good et al and Keithley et al does not explicitly disclose a real estate supply database.

Walker et al ('878) discloses proposal requests (CPOs) that are returned for further consideration which are in a real estate supply database (500). Walker et al also discloses changing files and accessing the changed files by various parties.

It would have been obvious to one with ordinary skill in the art to discloses changing files and accessing the changed files by various parties (as claimed in claim 97) to Good et al because Walker et al ('878) teaches that offers may be modified over time which when viewed by all parties may result in acceptable conditions of a sale (col 2, lines 33-37).

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It would have been obvious to one with ordinary skill in the art to include to Good et al proposal requests where the requests are sent to landlords and proposals returned from landlords for further consideration by prospective tenants because of what is taught by Walker et al ('878). Walker et al ('878) teaches a buyer-driven system where the buyer dictates the terms of the offer (col 1, lines 23-34) and Good et al teaches a buyer driven rental market (col 2, lines 40-55).

It would have been obvious to one with ordinary skill in the art to include to Good et al an ad hoc real estate supply database because Walker et al ('878) teaches buyer driven paradigms where the buyer has expressed an interest (col 1, lines 26-34).

It would have been obvious to one with ordinary skill in the art to include RFIs to Good et al, where the requests are sent to landlords and responses returned from landlords for further consideration by prospective tenants, because of what is taught by Walker et al ('878). Walker et al ('878) teaches a buyer-driven system where the buyer dictates the terms of the offer (col 1, lines 23-34) and Good et al teaches a buyer driven rental market (col 2, lines 40-55).

Good et al in view of Keithley et al and further in view of Walker et al ('878) does not disclose non-binding specifications.

Walker et al ('129) discloses non-binding specifications (col 10, lines 65-67).

It would have been obvious to one with ordinary skill in the art to include non-binding specifications to Good et al in view of Keithley et al and further in view of Walker et al ('878) because Walker et al ('129) discloses that non-binding specifications allow leverage in negotiation (col 2, lines 65-67; col 3, lines 1-2).

12. Claims 3-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Good et al in view of Keithley et al and further in view of Walker et al ('878) in further view of Walker et al ('129) as applied to claims 1-2 above, and further in view of Bisdikian et al.

Good et al, Keithley et al, Walker et al ('878 or '129) do not disclose automatically comparing new entries for matches and then linking to a second database to find matches satisfying characteristics.

Bisdikian et al discloses automatically comparing new entries for matches (col 2, line 39) and then linking to a second database to find matches satisfying characteristics (col 2, lines 40-50).

It would have been obvious to one with ordinary skill in the art to include automatically comparing new entries for matches because Bisdikian et al teaches that search systems utilize matching techniques (col 1, line 50).

It would have been obvious to one with ordinary skill in the art to include linking to a second database to find matches satisfying characteristics because Bisdikian et al teaches that it is common to use different databases in search systems (col 1, lines 55-67).

13. Claims 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Good et al in view of Keithley et al and further in view of Walker et al ('878) in view of Walker et al ('129) further in view of Bisdikian et al as applied to claims 3-8 above, and further in view of Campbell et al.

Good et al, Keithley et al, Walker et al ('878 or '129), or Bisdikian do not disclose selecting proposals from a RFP and sending the RFP to each landlord match.

Campbell et al discloses selecting proposals from a RFP (para 0036) and sending the RFP to each landlord match (para 0036).

It would have been obvious to one with ordinary skill in the art to include selecting proposals from a RFP to Good et al in view of Keithley et al and further in view of Walker et al ('878) because Campbell et al teaches that criteria varies regarding providers (para 0004)

It would have been obvious to one with ordinary skill in the art to include sending the RFP to each landlord match because Cambell et al teaches that to complete a transaction using RFPs require sending out the complete RFP to all providers (para 0036).

Response to Arguments

14. Applicant's arguments with respect to claims 1-23 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alain L. Bashore whose telephone number is 703-308-1884. The examiner can normally be reached on about 7:00 am to 4:30 pm (Monday thru Thursday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 703-308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Alain L. Bashore